

#48 P7  
8/6/01

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Paul R. Schimmel

Serial No: 08/249,689

Art Unit: 1805

Filed: May 26, 1994

Examiner: J. Brusca

For: *"DESIGNING COMPOUNDS SPECIFICALLY INHIBITING RIBONUCLEIC  
ACID FUNCTION"*Assistant Commissioner  
for Patents  
Washington, D.C. 20231**TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE  
PATENTING REJECTION OVER A PENDING SECOND APPLICATION**

Sir:

Petitioner, Massachusetts Institute of Technology, is the owner of the entire interest in the above-identified application as evidenced by the accompanying Certificate under 37 C.F.R. § 3.73(b). Petitioner hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154-156 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on a pending second U.S. patent application no. 07/929,834, filed on August 14, 1992, or any continuation thereof under 37 C.F.R. § 1.62. Petitioner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

U.S.S.N. 08/269,589

Filed: May 26, 1994

TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE  
PATENTING REJECTION OVER A PENDING SECOND APPLICATION

In making the above disclaimer, petitioner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154-156 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

The undersigned (whose title is supplied below) is empowered to act on behalf of Massachusetts Institute of Technology.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

**T. D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT**

DATE: 6/20/01  
EXAMINER: BRUSCA  
PAULINE FARRIER  
COM: PATENT ANALYST  
PARALEGAL SPECIALIST

APPL. S.N.: 08/249689  
ART UNIT: 1631

SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: 8/6/01

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete, please initial, date and return this memo to me. THANK YOU.

- ☒ The T.D. is PROPER and has been recorded (see ¶14.23).
- ☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see ¶14.24):
- ☐ The recording fee of \$ \_\_\_\_\_ has not been submitted nor is there any authorization in the application file for the use of a deposit account (see ¶14.26.07).
  - ☐ The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see ¶¶14.26 & 14.26.01).
  - ☐ The T.D. lacks the enforceable only during common ownership clause - needed to overcome a double patenting rejection, Rule 321(b) (see ¶14.27.01)
  - ☐ The T.D. is directed to a particular claim(s), which is not acceptable since "the disclaimer must be a terminal portion of the term of the entire patent to be granted." (MPEP 1490) (see ¶¶14.26 & 14.26.02).
  - ☐ The person who signed the T.D.:
    - ☐ is not an attorney "of record" (see ¶¶14.29 and 14.29.01).
    - ☐ has failed to state his/her capacity to sign for the business entity (see ¶14.28),
    - ☐ is not recognized as an officer of the assignee (see ¶¶14.29 & possibly 14.29.02).
  - ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶14.30).
  - ☐ The T.D. is not signed (see ¶¶14.26 & 14.26.03).
  - ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶14.32).
  - ☐ The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see ¶¶14.26, 14.26.04 or 14.26.05).
  - ☐ The period disclaimed is incorrect or not specified (see ¶¶14.26, 14.27.02 or 14.27.03).
  - ☐ Other:
  - ☐ Suggestion to request refund (see ¶14.36). NOTE: If already authorized, credit refund to deposit account and do not check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex. Initials: \_\_\_\_\_ Date: \_\_\_\_\_

(Rev. 5/98)

RETURN THIS MEMO TO CPK3-4925.

MPEP 1400-53

Rev. 1 Feb 2000